

**Remarks**

This Application has been carefully reviewed in light of the Office Action mailed April 5, 2005. Applicants believe all pending claims are allowable without amendment and respectfully provide the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

**I. The Claims are Allowable over the Double Patenting Rejections**

The Examiner rejects Claims 1-46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-31 of U.S. Patent 6,665,305 (the "305 Patent"). Applicants respectfully disagree.

**A. The Obviousness-Type Double Patenting Standard**

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? *See* M.P.E.P. § 804(II)(B)(1). An obviousness-type double patenting rejection is proper only when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. *Id.* The term "distinct" means two or more subjects as disclosed are related, for example, as combination and sub-combination thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of prior art). *See* M.P.E.P. § 802.01. Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *See* M.P.E.P. § 804(II)(B)(1). A double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. § 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued patent. *See* M.P.E.P. § 804(III).

**B. The Applicable Obviousness Standard under 35 U.S.C. § 103**

The question raised under 35 U.S.C. § 103 is whether the prior art (or in this case, the '305 Patent) taken as a whole would suggest the claimed invention taken as a whole to one of

ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references (or in this case, the '305 Patent), which is certainly not the case here as the Examiner acknowledges, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art (or in this case, the '305 Patent) why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference (or in this case, the '305 Patent) to arrive at the claimed invention. It is clear based at least on the distinctions discussed below that the proposed modifications to the '305 Patent do not, taken as a whole, suggest the claimed invention, taken as a whole.

The strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of references, which is set forth in the M.P.E.P. and governing Federal Circuit case law, is discussed in detail below in Section II.A.2.i. To avoid burdening the record, Applicants do not reproduce that standard in this Section but respectfully direct the Examiner's attention to Section II.A.2.i.

**C. A *Prima Facie* Case of Obviousness has not been Established**

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to Claims 1-46 of the present Application in view of Claims 1-31 of the '305 Patent. Thus, Applicants respectfully request the Examiner to withdraw the obviousness-type double patenting rejection of Claims 1-46. As an example, Applicants discuss Claim 1 of the present Application, which the Examiner apparently discusses in relation to Claim 1 of the '305 Patent. (Office Action, Pages 3-4) Claim 1 of the present Application recites patentable distinctions from Claim 1 of the '305 Patent.

As an example, Claim 1 of the present Application recites "a processor . . . operable to . . . compare the path information for the particular subscriber [identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server] to the particular virtual circuit used to receive the communication from the particular subscriber" and "identify the particular subscriber for connection to the second communication network based on the comparison," which is not specifically recited in Claim 1 of the '305 Patent. The Examiner acknowledges that the '305 Patent does not "specifically

disclose [comparing] the path information for the particular subscriber to the particular virtual circuit as described in claim 2 of the instant application.” (Office Action, Page 3) However, the Examiner argues that “it would have been obvious to a person of skill in the art to recognize that the two [sets] of claims are similar because the determination from [the] physical address and virtual circuit of the ‘305 patent would enable [sic] to identify the subscriber as disclosed in the instant application so that proper connection can be made between devices.” (Office Action, Pages 3-4) Applicants respectfully disagree.

First, the question is not whether one of ordinary skill in the art “would recognize that the two sets of claims are similar,” as asserted by the Examiner. The Examiner has acknowledged that Claim 1 of the ‘305 Patent does not specifically disclose the above-discussed limitations recited in Claim 1 of the present Application. The question is whether there exists the requisite teaching, suggestion, or motivation in the prior art to modify Claim 1 of the ‘305 Patent in the manner the Examiner proposes. Applicants respectfully submit that there is not. Moreover, Applicants respectfully submit that the Examiner’s statement evidences the Examiner’s use of hindsight in an attempt to render Applicants’ Claim 1 obvious. Applicants respectfully submit that this statement, made with the benefit of hindsight with Applicants’ claims in view, is insufficient to establish a *prima facie* case of obviousness. In particular, Applicants respectfully submit there has been no showing of the required teaching, suggestion, or motivation to modify Claim 1 of the ‘305 Patent to recite at least the above-identified limitations recited in Claim 1 of the present Application. Accordingly, since the ‘305 Patent and the prior art fails to provide the required teaching, suggestion, or motivation to modify Claim 1 of the ‘305 Patent in the manner proposed, Applicants respectfully submit that the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness (or in this case, a *prima facie* case of obviousness-type double patenting) have not been met. Applicants respectfully submit that analogous reasoning applies with respect to independent Claims 11, 18, 26, 32, 36, and 40.

With respect to dependent Claims 2-10, 12-17, 19-25, 27-31, 33-35, 37-39, and 41-46, the Examiner states that “they [depend] on rejected claims [and so] they are rejected under the judicially created doctrine of obviousness-type double patenting.” (Office Action,

Page 4) First, Applicants respectfully submit that these dependent claims are allowable at least because of their dependence on allowable independent claims. Second, Applicants respectfully submit that the Examiner's statement provides an improper basis for rejecting these dependent claims under the judicially created obviousness-type double patenting. In particular, even assuming for the sake of argument only that the independent claims of the present Application were properly rejected based on the claims of the '305 Patent (with which Applicants do not agree), that fact would not mean that the dependent claims are properly rejected (i.e., that one or more claims in the '305 Patent render any of the dependent claims of the present Application obvious). Applicants respectfully submit that the Examiner must perform a proper analysis with respect to each dependent claim in order to properly maintain this rejection. In other words, regardless of whether the independent claims are properly rejected based on the '305 Patent, the Examiner must still pair up dependent Claims 2-10, 12-17, 19-25, 27-31, 33-35, 37-39, and 41-46 of the present Application with one or more claims of the '305 Patent for purposes of indicating which claims of the '305 Patent the Examiner believes renders these dependent claims of the present Application obvious.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the non-statutory obviousness-type double patenting rejection of independent Claim 1 and its dependent claims. For at least analogous reasons, Applicants respectfully request that the Examiner withdraw the non-statutory obviousness-type double patenting rejection of independent Claims 11, 18, 26, 32, 36, and 40 and their dependent claims.

## **II. The Claims are Allowable over the Rejections under 35 U.S.C. § 103**

### **A. The Claims are Allowable over the Proposed *Vandette-Kobayasi* Combination**

The Examiner rejects Claims 1-5, 8-21, 24-33, 36-37, and 40-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,785,228 to Vandette, et al. ("*Vandette*") in view of U.S. Patent 6,456,623 to Kobayasi, et al. ("*Kobayasi*"). Applicants respectfully disagree and discuss independent Claim 1 as an example.

**1. The Proposed *Vandette-Kobayasi* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1**

At a minimum, the proposed *Vandette-Kobayasi* combination does not disclose, teach, or suggest at least the following limitations recited in Claim 1:

- a processor coupled to the memory and operable to:
  - compare the path information for the particular subscriber [identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server] to the particular virtual circuit used to receive the communication from the particular subscriber; and
  - identify the particular subscriber for connection to the second communication network based on the comparison.

The Examiner acknowledges that *Vandette* does not disclose these limitations. (Office Action, Page 5) However, the Examiner argues that *Kobayasi* discloses these limitations. (Office Action, Pages 5-6) Applicants respectfully disagree.

*Kobayasi* discloses a line switching method for use in an ATM system. In conventional methods, according to *Kobayasi*, when a call from a subscriber accommodated in a subscriber circuit 1 linked to a line concentration and distribution device 2 is addressed to a subscriber connected to a subscriber circuit 1 that is also connected to the same line concentration and distribution device 2 (i.e., the destination subscriber circuit 1 is connected to the same line concentration and distribution device 2 as the source subscriber circuit 1), the call is passed through a switch section 3 in the exchange. This means that switch section 3 is being used unnecessarily because the line concentration and distribution device 2 to which both the destination and source subscriber circuits are connected could have been used to connect the call without involving switch section 3. (See *Kobayasi*, Figure 6, 1:51-63)

The apparent purpose of *Kobayasi* is to reduce processing at switch section 3 and allow for at least certain connections to be made even if switch section 3 fails. (*Kobayasi*, 1:66-2:3) To accomplish this goal, *Kobayasi* appears to disclose, using a loop-back circuit, adding a decision at line concentration and distribution device 2 to determine whether the source and destination subscriber circuits are connected to the same line concentration and distribution device 2. In particular, *Kobayasi* discloses “comparing information for identifying a path of a subscriber’s cell with information registered in a monitor table” and

“detecting that a first subscriber circuit for accommodating a called subscriber is connected to a same line concentration and distribution device to which a second subscriber circuit for accommodating calling subscriber is connected.” (*Kobayasi*, Abstract, 2:10-16) If so, there is no need to invoke switch section 3 to complete the call because the system simply loops back and connects the call sent from the calling subscriber to the called subscriber without passing through switching section 3. (*Kobayasi*, 2:16-18) Thus, *Kobayasi* is clearly performing a comparison of information for determining whether the **destination** subscriber circuit of a call is connected to the same line concentration and distribution device 2 as the source of the call, eliminating the need to forward the call to the switch section 3 for processing. To make this determination, the system disclosed in *Kobayasi* must be comparing destination information of a call cell with information regarding destination subscribers to determine if the destination subscriber of the call is also connected to the line concentration and distribution device (See *Kobayasi*, 2:10-16, 47-57).

In contrast, Applicants’ independent Claim 1 recites “a processor . . . operable to . . . compare the path information for the particular subscriber [identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server] to the particular virtual circuit used to receive the communication from the particular subscriber” and “identify the particular subscriber for connection to the second communication network based on the comparison.” The comparison disclosed in *Kobayasi* does not appear to involve comparing the particular virtual circuit used to receive a communication **from a particular subscriber** to path information **for the particular subscriber** [that identifies a virtual circuit that is pre-assigned to **the particular subscriber** for communicating with the access server], as recited in Claim 1. Indeed, Applicants respectfully submit that if the comparison disclosed in *Kobayasi* were interpreted to be the same as the comparison recited in Claim 1, *Kobayasi* would be rendered inoperable for its intended purpose. To explain, if the comparison disclosed in *Kobayasi* were interpreted as “compar[ing] the path information for the particular subscriber [identifying a virtual circuit that is pre-assigned to the particular subscriber for communicating with the access server] to the particular virtual circuit used to receive the communication from the particular subscriber,” then the system disclosed in *Kobayasi* would not be able to determine whether the destination subscriber circuit of a call is connected to the same line concentration and distribution device 2 as the source of the call,

and thus could not eliminate the need to forward the call to the switch section 3 for processing.

Moreover, at least because *Kobayasi* fails to disclose, teach, or suggest a processor operable to “compare the path information for the particular subscriber to the particular virtual circuit used to receive the communication from the particular subscriber,” *Kobayasi* necessarily fails to disclose, teach, or suggest that the processor is operable to “identify *the particular subscriber* for connection to the second communication network *based on the comparison.*”

For at least these reasons, Applicants respectfully submit that the proposed *Vandette-Kobayasi* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. For at least certain analogous reasons, Applicants respectfully submit that the proposed *Vandette-Kobayasi* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 11, 18, 26, 32, 36, and 40.

## **2. The Proposed *Vandette-Kobayasi* Combination is Improper**

The rejection of Applicants’ claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Vandette*, *Kobayasi*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify the *Vandette* or *Kobayasi* in the manner the Examiner proposes. The rejected claims are allowable for at least this additional reason.

### **i. The Obviousness Standard**

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See id.* (citations omitted). Moreover, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>1</sup> According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re*

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<sup>1</sup> Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).



*Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432; *see also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation

in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

## **ii. Argument**

With regard to the proposed *Vandette-Kobayasi* combination, the Examiner states that “it would have been obvious to a person of skill in the art at the time the invention was made to combine the teaching of *Vandette* and *Kobayasi* because *Kobayasi*’s teaching would allow [sic] to determine proper communication paths between computers to prevent connection error.” (Office Action, Page 3). Applicants respectfully submit that the Examiner’s assertion that it would have been obvious to combine the teachings of *Vandette* with the teachings of *Kobayasi* to purportedly arrive at Applicants’ invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

First, the Examiner has not cited any portion of either *Vandette* or *Kobayasi* as purportedly providing the requisite teaching, suggestion, or motivation for combining these references in the manner the Examiner proposes. Instead, the Examiner merely provides a conclusory assertion that “it would have been obvious” because “*Kobayasi*’s teaching would allow [sic] to determine proper communication paths between computers to prevent connection error.” (Office Action, Page 3) *Vandette* is directed to a method for reducing resource usage of a switching section and facilitating operations for connection in high speed even if a failure occurs on the switching section by a line switching method. (Abstract)

*Kobayasi* is directed to a line switching method for reducing resource usage of a switching section and facilitating operations for connection in high speed even if a failure occurs on the switching section. (Abstract) Applicants respectfully submit that the Examiner has not pointed to any portions of *Vandette*, *Kobayasi*, or the knowledge generally available to one of ordinary skill in the art at the time of invention that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the particular line switching method for reducing resource usage of a switching section and facilitating operations for connection in high speed even if a failure occurs on the switching section that is disclosed in *Kobayasi* with the particular method for implementing subscriber permissions and restrictions for switched connections in a communications network that is disclosed in *Vandette*. This is inconsistent with the M.P.E.P and controlling Federal Circuit case law, which requires a showing of a specific teaching, suggestion, motivation for combining or modifying the references in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of invention.

Second, the fact that *Kobayasi*'s teaching may "allow [sic] to determine proper communication paths between computers to prevent connection error," even if this conclusory statement were supported by the references (which Applicants do not concede), has no bearing on the limitations recited in Applicants' claims. For example, even assuming for the sake of argument that the comparison disclosed in *Kobayasi* could be equated with the comparison recited in Claim 1 (which, as discussed above, it cannot), this purported motivation does not explain why one of ordinary skill in the art at the time of the invention would, based solely on the prior art, *even attempt* to incorporate into the method disclosed in *Vandette* the techniques disclosed in *Kobayasi*. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the method disclosed in *Vandette* the techniques disclosed in *Kobayasi*, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

In light of the foregoing, Applicants respectfully submit that the Examiner's proposed combination of *Vandette* with *Kobayasi* appears to be merely an attempt, with the benefit of

hindsight, to reconstruct Applicants' claims and is unsupported by the teachings of *Vandette* and *Kobayasi*.

For at least these additional reasons, Applicants respectfully submit that the proposed *Vandette-Kobayasi* combination does not support a *prima facie* case of obviousness.

### **3. Conclusion**

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claims 11, 18, 26, 32, 36, and 40 and their dependent claims.

#### **B. The Dependent Claims are Allowable over the Proposed *Vandette-Kobayasi-Malkin* Combination**

The Examiner rejects Claims 6-7, 22-23, 34-35, and 38-39 under 35 U.S.C. § 103(a) as being unpatentable over *Vandette* in view of *Kobayasi*, and further in view of U.S. Patent 6,061,650 to Malkin, et al. ("*Malkin*").

Dependent Claims 6-7, 22-23, 34-35, and 38-39 depend from independent Claims 1, 18, 32, and 36, respectively, which Applicants have shown above to be clearly allowable over the Examiner's proposed *Vandette-Kobayasi* combination. *Malkin* fails to make up for at least the deficiencies of the proposed *Vandette-Kobayasi* combination discussed above. Thus, dependent Claims 6-7, 22-23, 34-35, and 38-39 are allowable at least because of they depend from allowable independent claims. Additionally, dependent Claims 6-7, 22-23, 34-35, and 38-39 recite further patentable distinctions over the references cited by the Examiner. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 18, 32, and 36, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Additionally, Applicants do not admit that the proposed *Vandette-Kobayasi-Malkin* combination is even possible or that the Examiner has shown the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of invention to combine or modify these references in the manner the Examiner proposes.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 6-7, 22-23, 34-35, and 38-39.

**III. No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

**Conclusion**

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicants, at the Examiner's convenience at (214) 953-6581.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicants



Chad D. Terrell  
Reg. No. 52,279

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Customer No. **05073**